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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/488,381 | 01/20/2000 | Gaetano Bonasia | 0267-001-1522 | 4363 |

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07/10/2003

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EXAMINER

MAUNG, ZARNI

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 07/10/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/488,381 | BONASIA ET AL. | |
| | Examiner | Art Unit | |
| | Zarni Maung | 2154 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This office action is responsive to Application filed on January 20, 2000. Claims 1-31 are presented for further examination.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1 is directed to a method of adding a device including the steps of binding said device as a first device to be bound when the device is to be installed; binding said device as an additional device when said device is not the device to be installed, and binding said device as existing device to be bound when said device was previously installed in a network, classified in **Class 710, subclass 15**.

II. Claims 2-9 and 18 are directed to method of installing and binding a device by placing said device in a first-device installation mode of operation, classified in **Class 709, subclass 222**.

III. Claims 10-17 and 19-20 are directed to a method of installing a device by placing said device in an additional-device installation mode of operation, classified in **Class 709, subclass 221**.

IV. Claims 21-26 are directed to a method of installing a device by placing said device in existing-device mode of operation, classified in **Class 709, subclass 250**.

V. Claims 27-31 are directed to method for adding a CEBus compatible device by issuing a connect command to a context and hailing for a house code, classified in **Class 710, subclass 8**.

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19. Inventions I , II, III, IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I is directed to a method for binding a device as a first device to be bound when the device is to be installed; binding said device as an additional device when said device is not the device to be installed, and binding said device as existing device to be bound when said device was previously installed in a network classified in different **Classes/subclasses**. Invention II or claims 2-9 and 18 are directed to method of installing and binding a device by placing said device in a first-device installation mode of operation, classified in **Class 709, subclass 222**. Invention III or claims 10-17 and 19-20 are directed to a method of installing a device by placing said device in an additional-device installation mode of operation, classified in **Class 709, subclass 221**. Invention IV or claims 21-26 are directed to a method of installing a device by placing said device in existing-device mode of operation, classified in **Class 709, subclass 250**. Invention V or claims 27-31 are directed to method for adding a CEBus compatible device by issuing a connect command to a context and hailing for a house code, classified in Class 710, subclass 8. And, in this combination, Invention I, as claimed does not require the particulars of the subcombination as claimed because the Invention I does not explicitly require all the detailed limitations recited in claims 2-31. ***More specifically, Invention I does not require to place the device in one particular mode and does not require by issuing a connect command to a context and hailing for a house code.*** The subcombination has separate utility such

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as placing the device in a one of specified mode of operation and issuing a connect command to a context and hailing for a house code, classified in a different Class/Subclass. See M.P.E.P. § 806.05(d).

20. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

21. For example, the searches for five inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claim 1) would require use of search **Class 710, subclass 15** (not require for the inventions II, III, IV and V).

(b) the Group II search (claims 2-9 and 18) would require use of search **Class 709 subclass 222** (not require for the inventions I, III, IV and V).

(c) the Group III search (claims 10-17 and 19-20) would require use of search **Class 709 subclass 221** (not require for the inventions I, II, IV and V).

(d) the Group IV search (claims 21-26) would require use of search **Class 709 subclass 250** (not require for the inventions I, II, III, and V).

(e) the Group V search (claims 27-31) would require use of search **Class 710 subclass 8** (not require for the inventions I, II, III and IV).

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3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5. A shortened statutory period for response to this action is set to expire **0 (zero) months and 30 (thirty) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zarni Maung whose telephone number is (703) 308-6687. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax phone number for this Group is (703) 308-9052. Additionally, the fax numbers for Group 2100 are as follows:

Official Faxes: (703) 746-7239
After Final Responses: (703) 746-7238

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Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-3900.

July 9, 2003


ZARNI MAUNG
PRIMARY EXAMINER